

REMARKS

This is intended as a full and complete response to the Final Office Action dated November 17, 2004, having a shortened statutory period for response set to expire on February 17, 2005. Claims 21-40 remain pending in the application and are shown above. Claims 21-26, 28-31 and 33-40 stand rejected, and claims 27 and 32 are indicated to be allowable by the Examiner. Please reconsider the claims pending in the application for reasons discussed below.

Claim Objections

The Examiner objected to claim 21 because of informalities which have been corrected.

Claim Rejections - 35 USC § 103

Claims 21-26, 28-31 and 33-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cumming, et al.* (U.S. Patent No. 6,070,671) in view of *Simpson* (U.S. Patent No. 6,457,532). The Examiner states that modifying *Cumming, et al.* to use the expander of *Simpson* would have reduced the difficulty in expanding tubulars in non-vertical or deviated wellbores that arises from the pulling forces or pressures required to operate other expanders.

Applicants respectfully submit that modifying *Cumming, et al.* to use the expander of *Simpson* is not obvious. Specifically, the mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See, MPEP § 2143.01. However, the nature of the problem to be solved in *Simpson* is not related to expanding a tubular through a window such that the teachings therein would not have suggested its use for solving any problems related to expanding a tubular through a window, as disclosed in *Cumming, et al.* Further, *Cumming, et al.* teaches creating an interference fit capable of achieving a shear bond and a hydraulic seal due to a hard fixed diameter conical ceramic surface that presses a tubular into mating surfaces at a window. See, column 1,

Page 6

lines 56-63. The interference fit and shear bond occur due to the fact that the cone actually deforms the tubular around the matting surfaces since the cone cannot adjust inward at the matting surfaces, thereby making the fixed diameter a desired feature in *Cumming, et al.* For the foregoing reasons, the combined teachings of *Cumming, et al.* and *Simpson*, the knowledge of one of ordinary skill in the art and the nature of the problem to be solved as a whole would not have suggested combining these references.

Further, the factual inquiry whether to combine references must be based on objective evidence of record, otherwise the proposed motivation is improper hindsight. See, *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir., 2002). This factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. *Id.* However, the Examiner presently proposes a motivation for combining the expander of *Simpson* with the method of *Cumming, et al.* without providing any objective authority that identifies such problems associated with expanding a tubular through a window.

In conclusion, the cited references cannot be properly combined to render the claims obvious. Thus, *Cumming, et al.* in view of *Simpson* fails to teach, show or suggest expanding a liner extending into a lateral wellbore through a window with an expander having features as claimed. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Allowable Subject Matter

Claims 27 and 32 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants submit that claims 27 and 32 are allowable based at least on the traversal presented above regarding the independent claims from which these claims depend. Accordingly, Applicants respectfully request withdrawal of the objection and allowance of the claims.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the Final Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Final Office Action.

The references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the Final Office Action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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